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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,701	02/27/2004	Yuichi Wada	488-00067	7025

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EXAMINER

DANG, ROBERT TRONG

ART UNIT PAPER NUMBER

2838

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/788,701	Applicant(s) WADA, YUICHI	
	Examiner Robert T. Dang	Art Unit 2838	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/27/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Oshiro (JP 2001260666 A).

As to claim 1, Oshiro discloses in figure 6b, an antistatic protector to be mounted to a conductive connector (61) for joining a resin tube (99) and a pipe (98) in automotive piping to earth the resin tube via the conductive connector, comprising; a mounting portion to be mounted to an outer periphery of the conductive connector (61), a connecting portion to be connected to an earth member provided on a car body, an elongate or relatively elongate connective portion to joint the mounting portion (63) and the connecting portion (50), and the mounting portion, the connecting portion (50) and the connective portion (34) wherein the connective portion is formed from a conductive elastic material (see paragraph [0014] of Means).

As to claim 2, Oshiro discloses in figure 6a, the antistatic protector as set forth in claim 1 wherein the mounting portion (63), the connecting portion (50) and the connective portion (34) are formed as a unit.

As to claims 3 and 6, Oshiro discloses in figure 6b, wherein the mounting portion (63) is formed as an annular member so as to be fitted on and mounted to the outer periphery (50) of the connector (13b) (see paragraph [0055] of Detailed Description)

As to claim 4, Oshiro discloses in figure 6, wherein the mounting portion (63) is constructed by a pair of halved portions which are joined each other to form the annular member, the annular member is configured so as to be mounted to the outer periphery of the conductive connector (61) with the conductive connector there between. The annular member is one unit all joined together. Prior to joining is not material since the claim requires a joined structure met by the reference. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See 2113 [Product-by-Process Claims]

As to claim 5, Oshiro discloses in figure 6, wherein the mounting portion (63) is formed in a cap configuration so as to be capped on and mounted to the outer periphery (51) of the conductive connector (61) (see paragraph [0056] of Detailed Description).

As to claim 7, Oshiro discloses in figure 6, wherein the mounting portion is mounted to the outer periphery (51) of the connector (13b) rotatably.

As to claim 8, Oshiro discloses in figure 6, wherein the connecting portion is provided integrally with one or more finger grips (20) projecting outwardly.

As to claim 9, Oshiro discloses in figure 6, wherein the finger grips (20) are formed on opposite sides of the connecting portion respectively.

As to claims 10-11, Oshiro discloses in figure 6, wherein the conductive connector (61) is formed with a pair of positioning surfaces (21) expanding radially outwardly on an outer periphery in axially spaced and opposed relation, and the mounting portion is to be mounted between a pair of the positioning surfaces to be positioned axially.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert T. Dang whose telephone number is 571-272-8326. The examiner can normally be reached on M-F, 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Karl D. Easthom can be reached on 571-272-1989. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KARL EASTHOM
SUPERVISORY PATENT EXAMINER